



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

52

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/187,700	11/06/1998	HIROYUKI KOBAYASHI	3408.62676	3400

24978 7590 05/16/2005

GREER, BURNS & CRAIN
300 S WACKER DR
25TH FLOOR
CHICAGO, IL 60606

EXAMINER

NGUYEN, MINH DIEU T

ART UNIT	PAPER NUMBER
----------	--------------

2137

DATE MAILED: 05/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/187,700	Applicant(s) KOBAYASHI ET AL.	
	Examiner Minh Dieu Nguyen	Art Unit 2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-20, 25 and 26 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 21-24 and 27-28 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>07/12/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-20 and 25-26, drawn to method and apparatus for protecting data on a storage medium having a plurality of unit storage areas comprising a step of generating a different random key for each storage area of the plurality of unit storage areas and a step of encrypting the random key with a password, classified in class 713, subclass 193.
 - II. Claims 21-24 and 27-28, drawn to method and apparatus for protecting data on a storage medium comprising a step of generating a random key, and a step of encrypting the random key with each of a plurality of passwords, classified in class 713, subclass 193.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the Inventions I and II are not disclosed as capable of use together since Invention I appears to direct to the first embodiment and Invention II appears to direct to the fourth embodiment. Invention I and II have different modes of operation, invention I requires the random key is encrypted with a password, i.e. single and

invention II requires the random key is encrypted with a plurality of passwords, i.e. multiple.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by Petreley (Security report: Windows vs Linux). Petreley discloses Windows has only recently evolved from a single user design to a multi-user level (page 8), the evolvement indicates single user system is a separate status than multi-user system.

4. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 21-24 and 27-28 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

5. During a telephone conversation with Josh Snider on 5/11/05 a provisional election was made with traverse to prosecute the invention of group I, claims 1-20 and 25-26. Affirmation of this election must be made by applicant in replying to this Office action. Claims 21-24 and 27-28 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Allowable Subject Matter

6. Claims 1-20 and 25-26 are allowed.

Each claim 1, 8, 18-20 and 25-26 identifies the uniquely distinct features "generating a different random key for each unit storage area of the plurality of unit

Art Unit: 2137

storage areas"; "assigning the different random key to each unit storage area being based on a particular unit storage area to which the data, once encrypted, is to be stored", and "writing each of the encrypted different random keys to the storage medium when initializing the storage medium. The closest prior arts, Ganesan (5,748,735), Kaufman (6,178,508), Cruets et al. (4,780,905), Blakley (5,677,952), Bertina (5,682,027) and Shear (4,827,508), alone or in combination, fail to anticipate or render the above limitations obvious.

7. This application is in condition for allowance except for the presence of claims 21-24 and 27-28 to an invention non-elected with traverse in the reply filed on July 22, 2004. Applicant is given ONE MONTH or THIRTY DAYS from the date of this letter, whichever is longer, to cancel the noted claims or take other appropriate action (37 CFR 1.144). Failure to take action during this period will be treated as authorization to cancel the noted claims by Examiner's Amendment and pass the case to issue. Extensions of time under 37 CFR 1.136(a) will not be permitted since this application will be passed to issue.

The prosecution of this case is closed except for consideration of the above matter.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Dieu Nguyen whose telephone number is 571-272-3873. The examiner can normally be reached on M-F 6:00-2:30.

Art Unit: 2137

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on 571-272-3868. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2100.

Minh Dieu Nguyen
Examiner
Art Unit 2137

mdn
5/11/05

A handwritten signature in black ink, appearing to read "Andrew Caldwell", with a stylized flourish at the end.

ANDREW CALDWELL
SUPERVISORY PATENT EXAMINER